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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,486	09/27/1999	YOICHIRO SAKO	450100-02102	1659

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/406,486

Applicant(s)

SAKO ET AL.

Examiner

Firman Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4th, 2004 has been entered.

Response to Amendment

2. An amendment has been filed on February 4th, 2004. In the amendment, claims 1, 14-16, 18, 20, 22 have been amended, no claim has been canceled, and claims 23-26 have been added. Claims 1-26 are pending in the letter.

Response to Arguments

3. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Specification

4. The amendment filed February 4th, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall

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introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "all users".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 14-16, 18, 20, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants disclose "all user" in claims 1, 14-16, 18, 20, 22. The subject matter is not properly described in the application as filed. Therefore, Examiner takes the position of excluding the subject matter in the action since the claims are not fully in compliance with 35 USC 112.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1, 14-16, 18, 20, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1, 14-16, 18, 20, 22 recite the limitation "all user". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal (U.S. Patent No. 6,148,301) in view of Christenson et al (U.S. Patent No. 6,324,620) in further view of Derick (U.S. Patent No. 6,016,509).

12. As per claims 1, Rosenthal teaches an information distributing method (*information distributed system 10*) for distributing information subjected to billing (*see abstract, fig 2, column 3 lines 36-52*), characterized in that an amount of money billed every time the information is distributed (*see abstract, figs 1-3, column 5 lines 56-6 line 16*). Rosenthal fails to teach an inventive concept where distributed information is determined depending on the number

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of times that the information is distributed within a predetermined time period. However Christenson et al teach inventive concept where distributed information is determined depending on the number of times that the information is distributed within a predetermined time period (*see abstract, column 2 lines 51-54, 3 lines 56-67*). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify Rosenthal's inventive concept to include Christenson et al's inventive concept where distributed information is determined depending on the number of times that the information is distributed within a predetermined time period because this would have allow an information distribution technique which allows recipients the capability to easily change or modify document requests/received such that new/common subject matters that produced the greatest amount of revenue are easily added, and that the distribution non accessed subject matters are easily discontinued.

Furthermore, the combination of Rosenthal and Christenson et al fails to teach an inventive concept wherein the amount billed being determined independently each time the information is distributed. However, Derick teaches an inventive concept wherein the amount billed being determined independently each time the information is distributed (*see column 1 lines 37-45*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Rosenthal and Chirstenson et al to include Derick's inventive concept wherein the amount billed being determined independently each time the information is distributed because this would have ensure that appropriate charges are billed to the user for the correct amount of information distributed

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13. As per claims 2-8, Rosenthal teaches an information distributing method wherein the time period is one from a predetermined time point to a current time point, a definite term from a predetermined time point, one from an optionally set time point to a current time point or a second optionally set time point, a definite term down to the current time point and until an optionally set time point (*see column 6 lines 59-7 line 10*).

14. As per claims 9, 10, Rosenthal teaches an information distributing method wherein when the number of times of distribution reaches a previously set number of times or more, the amount of money billed for the information is raised or reduced (*see column 6 lines 59-7 line 10*).

15. As per claims 11, Rosenthal teaches an information distributing method wherein the amount of money billed for the information is determined depending on a value obtained by substituting the number of times of distribution for a previously set function (*see column 8 lines 16-47*).

16. As per claims 12, 13, Rosenthal teaches an information distributing method wherein the information is audio information, video information, game information or book information, or any combination of them distributed by using wireless communication or wired communication (*see column 4 lines 25-45*).

17. As per claims 14, 15, Rosenthal teaches an information distributing system (*information distributed system 10* for distributing information subjected to billing (*see abstract, fig 2, column*

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3 lines 36-52), characterized in that an amount of money billed every time the information is distributed (*see abstract, figs 1-3, column 5 lines 56-6 line 16, see also column 1 lines 61-2 line 9*). Rosenthal fails to teach an inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms. However Christenson et al teach inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms (*see abstract, column 2 lines 51-54, 3 lines 56-67*). Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify Rosenthal's inventive concept to include Christenson et al's inventive concept where distributed information is determined in a composite manner depending on the respective numbers of times that the information is distributed in a plurality of set terms because this would have allow an information distribution technique which allows recipients the capability to easily change or modify document requests/received such that new/common subject matters that produced the greatest amount of revenue are easily added, and that the distribution non accessed subject matters are easily discontinued. Furthermore, the combination of Rosenthal and Christenson et al fails to teach an inventive concept wherein the amount billed being determined independently each time the information is distributed.

However, Derick teaches an inventive concept wherein the amount billed being determined independently each time the information is distributed (*see column 1 lines 37-45*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Rosenthal and Chirstenson et al to include Derick's inventive concept wherein the amount billed being determined independently each time the information is

distributed because this would have ensure that appropriate charges are billed to the user for the correct amount of information distributed

18. As per claims 16, 18 and 20 Rosenthal teaches an information distributing system (*information distributed system 10*) for distributing information subjected to billing (*see abstract, figs 1-3, column 5 lines 56-6 line 16*), comprising an information distributing means for distributing the information to a user (*subscriber/recipient, 14*) means for controlling a billing system depending on the number of distribution counted (*see abstract, fig 2, column 3 lines 36-52 also see column 9 line 5-17*). Rosenthal fail to teach a transaction means comprised of a means for counting a number of distribution of the information to a user. However, Chistenson et al teach a transaction means comprised of a means for counting a number of distribution of the information to a user (*see 10 lines 2-13*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosenthal et al' inventive concept to include Christenson's transaction means comprised of a means for counting a number of distribution of the information to a user because this would have to prevent trashing and also provided and system wherein a utilization threshold is determined with respect to the average frequency of access in order to determine whether an information is overutilized, underutilized, or average. Such a threshold amount may be defined by the user with respect to a particular information distributed and could be adjusted accordingly to increase or decrease the distribution process. Furthermore, the combination of Rosenthal and Christenson et al fails to teach an inventive concept wherein the amount billed being determined independently each time the information is distributed. However, Derick teaches an inventive concept wherein the amount

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billed being determined independently each time the information is distributed (*see column 1 lines 37-45*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Rosenthal and Chirstenson et al to include Derick's inventive concept wherein the amount billed being determined independently each time the information is distributed because this would have ensure that appropriate charges are billed to the user for the correct amount of information distributed

19. As per claims 17, 19, 21, Rosenthal teaches an information distributing system wherein the transaction means comprises a means for comparing the counted distribution number with a reference value (*see column 9 line 5-17*).

20. As per claim 22, Rosenthal teaches a transaction method to control a billing system for an information distributing system (*information distributed system 10*) comprising charging the amount of money to be billed to each user for the next subsequent distribution of the content on the result of the previous distributions and bill each user the amount of money (*see abstract, fig 2, column 3 lines 36-52 also see column 9 line 5-17*). Rosenthal fail to teach a counting the number of times that content is previously distributed to each user during a predetermined time period. However, Chistenson et al teach a transaction method for counting the number of times that content is previously distributed to each user during a predetermined time period (*see 10 lines 2-13*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosenthal et al' inventive concept to include Christenson's transaction method for counting the number of times that content is previously distributed to

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each user during a predetermined time period because this would have to prevent trashing and also provided a system wherein a utilization threshold is determined with respect to the average frequency of access in order to determine whether an information is overutilized, underutilized, or average. Such a threshold amount may be defined by the user with respect to a particular information distributed and could be adjusted accordingly to increase or decrease the distribution process. Furthermore, the combination of Rosenthal and Christenson et al fails to teach an inventive concept wherein the amount billed being determined independently each time the information is distributed. However, Derick teaches an inventive concept wherein the amount billed being determined independently each time the information is distributed (*see column 1 lines 37-45*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Rosenthal and Christenson et al to include Derick's inventive concept wherein the amount billed being determined independently each time the information is distributed because this would have ensured that appropriate charges are billed to the user for the correct amount of information distributed.

21. As per claims 23-26, they are rejected under the same rationale as claims 1-22.

22. Applicant amended claims 1, 14-16, 18, 20, 22 by adding the limitation "all user" in the claims. Applicants argue that support for the added limitation can be found in pages 14-23 of the specification. However, after a thorough examination of the specification, Examiner found no support for the added limitation. Furthermore, Applicant argues that the prior art fails to teach an inventive concept wherein the distributed information has been downloaded by all users.

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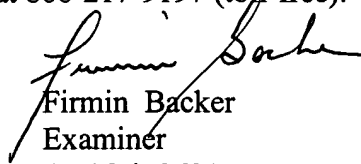
Examiner respectfully disagrees with applicants characterization of the prior art and argues that the added limitation fail to distinguish the claimed inventive concept over the prior arts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Examiner
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February 18, 2004